



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,354	02/14/2005	Koichi Goto	450100-05121	6316

7590 02/05/2008
William S Frommer
Frommer Lawrence & Haug
745 Fifth Avenue
New York, NY 10151

EXAMINER

KARIMI, PEGEMAN

ART UNIT	PAPER NUMBER
----------	--------------

2629

MAIL DATE	DELIVERY MODE
-----------	---------------

02/05/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/524,354	Applicant(s) GOTO ET AL.	
	Examiner Pegeman Karimi	Art Unit 2629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2008.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6 and 8-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1,2,4-6 and 8-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed on 01/11/2008 has been entered and considered by the examiner.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 4-6, and 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beernink (U.S. Patent No. 5,434,929) as modified by Dolan (U.S. Patent No. 5,148,015).

As to claims 1 and 5, Beernink teaches an input method using an input apparatus (10) in which

a touch panel (52 and 24') is laminated onto a display screen (72) of a display apparatus (50), (col. 5, lines 61-64),

a sensor unit (72) is formed so as to be expanded to the outside of one side of said display screen (i.e. 72 includes display screen 52 and keypad 24'. Keypad 24' is arranged outside of the side screen 52), (col. 4, lines 36-39)

an instruction (pop-up window of command icon) according to a touching position of a finger or a touch pen (38) onto said sensor unit is given (col.7, lines 39-47), and

a controller (18) generates a control signal on the basis of said instruction (col. 4, lines 1-2),

comprising the steps of:

displaying a selection display (76) comprising a plurality of selection items (82) along said side of said display screen (Horizontal side of the display) when the finger or the touch pen (38) is touched to said sensor unit (col. 8, lines 49-51, and lines 58-60);

and [[instructing selection of]] selecting said [[instructed]] highlighted selection item [[when]] upon lifting the finger or the touch pen (highlighting the elements of selection items 82 by touch pen 38 and selecting a desired selection by placing the touch pen on the screen and then lifting the touch pen), (col. 8, lines 45-50) from contact with said sensor unit (placing and then lifting the touch pen from the touch screen 51) at the position of the highlighted selection item_and (col. 9, lines 43-49), [[wherein said selection display disappears when the finger or the touch pen is moved (lifted) from said sensor unit to said display screen side]] (tapping on box 94, which is located on the display screen side, col. 9, lines 15-19), (col. 7, lines 47-50).

Beernink does not mention highlighting selection item as the finger or touch pen moved along said side on said sensor unit. Dolan teaches instructing one of (as can be seen in Fig. 1, when the user places his/her finger on sensor 15' the selection option 25 is highlighted) highlighting said highlighted selection items when the finger or the touch pen is near said selection items (col. 4, lines 56-63) as the finger or touch pen remains in contact with said sensor unit (as the user places his/her finger over the sensor the photo detector has activated and causes the selection to be highlighted) and is moved along said side on said sensor unit (col. 4, lines 64-67). Therefore it would have been obvious to one of ordinary skilled in the art at the time the invention was made to have added the highlighting selection item by the finger or the touch pen of Dolan to the input apparatus of Beernink because The highlighting of the desired selection by the user placing his finger over a reflective sensor lined up with the displayed item will normally be sufficient to inform the user of the choice that the has elected (col. 5, lines 6-9).

As to claim 12, this claim differs from claim 1 only in that the limitations "a controller to which an instruction according to a touching position of a finger or touch pen onto said sensor unit is given".

Beernink teaches a controller (18) to which an instruction (pop-up window of command icon) according to a touching position of a finger or touch pen (38) onto said sensor unit is given (col. 7, lines 39-47), (the display assembly 20 of pen-based computer system 10 is both an input and an output device and is coupled to I/O circuitry

18 by a bi-directional data bus 37, also when the buttons are selected by engaging the touch pen 38 the pressure is sensed and communicated to CPU 12 via data bus 37 and I/O 18, Fig. 1).

As to claims 2 and 6, Beernink teaches, operating a predetermined button (64) on a display/sensor unit of said touch panel (24') overlapped with said display screen (24' overlaps 72), an instruction corresponding to said button is generated (col. 5, lines 23-27 and col. 7, lines 39-42).

As to claims 4 and 8, Beernink teaches the selection display is a menu display (col. 7, lines 45-47).

As to claims 9 and 10, Beernink teaches said selection display is finished when the finger or the touch pen (38) is moved from said sensor unit to said display screen side (touch pen is moved from display screen 52 to display screen side location 94, where by tapping on close box 94 the user can finish a session), (col. 9, lines 15-19).

Response to Arguments

5. Applicant's arguments, see page 8, paragraph 4, filed on 1/11/2008, with respect to rejection(s) of claims 1 and 5 under 102(b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of new reference of Dolan (U.S. Patent No. 5,148,015).

On page 8, paragraph 4, applicant argues that Beernink merely discloses selecting an item by tapping and upon selection the item is highlighted and does not teach or suggest "highlighting a selection item as a finger or touch pen remains in contact with a sensor unit and is moved along the sensor unit". Reference of Dolan teaches highlighting a selection item (e.g. 25, Fig. 1) as a finger or touch pen (32) remains in contact with a sensor unit and is moved along the sensor unit (col. 4, lines 56-67), (as the user moves his/her finger from sensor 15' to sensor 15" the new selection 29 is selected and highlighted and the highlight of highlighted selection 25 will disappear).

On page 8, paragraph 5, applicant argues that Beernink merely discloses an order to select an item, the character is tapped and does not teach "the highlighted selection item is selected upon lifting the finger or touch pen from contact with the sensor unit". Beernink teaches the highlighted selection item is selected upon lifting the finger or touch pen from contact with the sensor unit (highlighting the elements of selection items 82 by touch pen 38 and selecting a desired selection by placing the touch pen on the screen and then lifting the touch pen), (placing and then lifting the touch pen from the touch screen 51), (col. 8, lines 45-50).

Applicant further argues that Beernink teaches away from the claimed invention since "the letter is never highlighted until selected and the letter is only highlighted upon tapping". Beernink clearly teaches the character selected is highlighted and this is performed by tapping on the desired character, wherein the user it involves placing the touch pen on the screen and then lifting the touch pen from the screen, which reads on

"the highlighted selection item is selected upon lifting the finger or touch pen from contact with the sensor unit".


Inquires

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pegeman Karimi whose telephone number is (571) 270-1712 and direct fax number is (571) 270-2712. The examiner can normally be reached on Monday-Thursday 8:00am - 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chanh Nguyen can be reached on (571) 272-7772. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Pegeman Karimi
February 1st, 2008


CHANH D. NGUYEN
SUPERVISORY PATENT EXAMINER